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IV. REMARKS

Claims 1–39, 42–55, and 60–66 are pending herein. Favorable reconsideration and allowance of claims 1–39, 42–55, and 60–66 is respectfully requested in view of the above amendments and the following remarks.

A. Allowed Claims 2, 10-39, 42-49 and 65.

The Applicant notes with appreciation the indication of allowance of claims 2, 10-39, 42-49 and 65.

B. Claim Rejections Under 35 U.S.C. § 102(b), and Alternatively Under 35 U.S.C. § 103(a).

1. Rejections Based on Wester '579.

Claims 1, 3, 8, 9, 54, 55, 64, and 66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,836,579 to Wester, *et al.* ("Wester '579"). The Examiner indicated that Wester '579 discloses inner casings (14 and 16 in FIG. 1) that are indirectly coupled to the interior surface of the outer casing (18 in FIG. 1).

a. Wester '579 does not teach all the elements of the current claims.

Claims 1, 3 and 64 are directed to a wellhead and an apparatus, and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." These limitations are not disclosed in Wester '579. As stated by the Examiner, Wester '579 discloses that the inner casings (14, 16) are indirectly coupled to the outer casing (18) by hangar assemblies (10, 12). Wester '579 does not disclose or suggest any contact pressure between the outer surface of each of the plurality of inner casings and the interior

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surface of the outer casing, as recited in claims 1, 3 and 64. Since Wester '579 does not teach or suggest all the limitations of the claims 1, 3 and 64, rejection under 35 U.S.C. § 102(b) is improper.

b. Wester '579 does not suggest or motivate the modification to eliminate the indirect coupling components.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference or combine the reference teachings. See MPEP § 706.02(j). The device taught in Wester '579 sufficiently couples the inner casing and the outer casing with the method described therein. The Wester '579 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical indirect coupling. The coupling components are prominent throughout the disclosure. If Wester '579 was modified to include expanding of the inner casing (or tubular member) such as covered by claims 1, 3 and 64, such expansion would supplant the important coupling components, defeating the purpose of the intricate indirect coupling. Accordingly, contrary to claims 1, 3 and 64, Wester '579 provides no suggestion or motivation to expand the inner casing (or tubular member) such that the outer surface of such inner casing (or tubular member) creates contact pressure with the inner surface of the outer casing (or tubular member). It is therefore improper to find eliminating these important indirect coupling components obvious under 35 U.S.C. § 103(a).

c. A product-by-process analysis of the claimed product does not warrant a finding as obvious over Wester '579.

Claims 1, 3, 64 and 66 possess product-by-process or product-by-process-like wording. Analysis of a product-by-process claim has two steps. The Examiner must first show that the claimed product appears to be the same or similar to that of the prior art. See MPEP § 2113. The second step is to determine if there is an unobvious difference between the claimed product and the prior art product, with the burden to establish an unobvious difference falling on the Applicant. See *Id.*

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Claims 1, 3 and 64 are directed to a wellhead and an apparatus, and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." In claim 66, contact pressure is implied by "expanding ... the inner tubular members into contact," and that contact pressure happens between "the inner tubular members" and "the interior surface of the outer tubular member."

i. The claimed product is not the same or similar to the prior art product.

The Applicant respectfully submits that a contact pressure coupling is not the same or similar to the complex indirect coupling of Wester '579. The Wester '579 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical coupling that the Examiner admits is indirect. Accordingly, the Examiner has failed to satisfy the first step in the analysis of a product-by-process claim and, therefore, the specific analysis for an unobvious difference between the products is unnecessary, and the claims should be allowable as being novel and non-obvious.

ii. There is an unobvious difference between the claimed product and the prior art product.

Assuming for the purpose of argument that the first step is met, the difference created by "expanding each inner casing (or tubular member)" imparts distinctive structural characteristics to the casing or tubing, e.g., having an outer surface devoid of components, so that a direct contact pressure may be established to an inner surface, similarly devoid of components. "The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially ... where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." MPEP § 2113. Terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" have been separately held to instill structural limitations, rather than merely describe a process. See, e.g., *In re Garner*, 412 F.2d 276, 279. "Expanding," in regards to a casing or

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tubular structure, should similarly be held to instill a structural limitation of having the same surfaces, devoid of components, in a larger diameter as the casing or tubular structure had in the original diameter. "Expanding" does not include adding the indirect coupling components essential to Wester '579.

Wester '579 teaches that components are essential to the indirect coupling. Wester '579 neither suggests nor motivates one to eliminate the indirect coupling components. As such, the wellhead and apparatus of claims 1, 3, 64 and 66 can not be obvious over Wester '579. Since the Applicant is able to prove an unobvious difference between the claimed product and the Wester '579 product, the claims should be allowable as being novel and non-obvious product-by-process claims.

Thus, because Wester '579 does not disclose all of the limitations in claims 1, 3 64, and 66, and because the product-by-process analysis dictated by MPEP 2113 does not result in a conclusion that the product of the claims is obvious, independent claims 1, 3, 64, and 66 are allowable over Wester '579. Dependent claims 8-9 and 54-55 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

2. Rejections Based on Jennings '063.

Claims 1, 3, 8, 9, 54, 55, 60-64, and 66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,595,063 to Jennings, *et al.* ("Jennings '063"). The Examiner Indicated that Jennings '063 discloses inner casings (26 and 28 in FIG. 1) that are indirectly coupled to the interior surface of the outer casing (38 in FIG. 1).

a. Jennings '063 does not teach all the elements of the current claims.

Claims 1, 3, 60 and 64 are directed to a wellhead and an apparatus, and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." These limitations are not

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disclosed in Jennings '063. As stated by the Examiner, Jennings '063 discloses that the inner casings (26, 28) are indirectly coupled to the outer casing (38) by hangar assemblies (20, 22). Jennings '063 does not disclose or suggest any contact pressure between the outer surface of each of the plurality of inner casings and the interior surface of the outer casing, as recited in the claim 1, 3, 60 and 64. Since Jennings '063 does not teach or suggest all the limitations of claims 1, 3, 60 and 64, rejection under 35 U.S.C. § 102(b) is improper.

b. Jennings '063 does not suggest or motivate the modification to eliminate the indirect coupling components.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference or combine the reference teachings. See MPEP § 706.02(j). The device taught in Jennings '063 sufficiently couples the inner casing and the outer casing with the method described therein. The Jennings '063 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical indirect coupling. The coupling components are prominent throughout the disclosure. If Jennings '063 was modified to include expanding of the inner casing (or tubular member) such as covered by claims 1, 3 and 64, such expansion would supplant the important coupling components, defeating the purpose of the intricate indirect coupling. Accordingly, contrary to claims 1, 3 and 64, Jennings '063 provides no suggestion or motivation to expand the inner casing (or tubular member) such that the outer surface of such inner casing (or tubular member) creates contact pressure with the inner surface of the outer casing (or tubular member). It is therefore improper to find eliminating these important indirect coupling components obvious under 35 U.S.C. § 103(a).

c. A product-by-process analysis of the claimed product does not warrant a finding as obvious over Jennings '063.

Claims 1, 3, 60, 64 and 66 possess product-by-process or product-by-process-like wording. Analysis of a product-by-process claim has two steps. The Examiner must first show that the claimed product appears to be the same or similar to that of the prior

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art. See MPEP § 2113. The second step is to determine if there is an unobvious difference between the claimed product and the prior art product, with the burden to establish an unobvious difference falling on the Applicant. See *Id.*

Claims 1, 3, 60 and 64 are directed to a wellhead and an apparatus, and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." In claim 66, contact pressure is implied by "expanding ... the inner tubular members into contact," and that contact pressure happens between "the inner tubular members" and "the interior surface of the outer tubular member."

I. The claimed product is not the same or similar to the prior art product.

The Applicant respectfully submits that a contact pressure coupling is not the same or similar to the complex indirect coupling of Jennings '063. The Jennings '063 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical coupling that the Examiner admits is indirect. Accordingly, the Examiner has failed to satisfy the first step in the analysis of a product-by-process claim, and, therefore, the specific analysis for an unobvious difference between the products is unnecessary, and the claims should be allowable as being novel and non-obvious.

ii. There is an unobvious difference between the claimed product and the prior art product.

Assuming for the purpose of argument that the first step is met, the difference created by "expanding each inner casing (or tubular member)" imparts distinctive structural characteristics to the casing or tubing, e.g., having an outer surface devoid of components, so that a direct contact pressure may be established to an inner surface, similarly devoid of components. "The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially ... where the manufacturing process steps would be expected to impart

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distinctive structural characteristics to the final product." MPEP § 2113. Terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" have been separately held to instill structural limitations, rather than merely describe a process. See, e.g., *In re Garnero*, 412 F.2d 276, 279. "Expanding," in regards to a casing or tubular structure, should similarly be held to instill a structural limitation of having the same surfaces, devoid of components, in a larger diameter as the casing or tubular structure had in the original diameter. "Expanding" does not include adding the indirect coupling components essential to Jennings '063.

Jennings '063 teaches that components are essential to the indirect coupling. Jennings '063 neither suggests nor motivates one to eliminate the indirect coupling components. As such, the wellhead and apparatus of claims 1, 3, 60, 64 and 66 can not be obvious over Jennings '063. Since the Applicant is able to prove an unobvious difference between the claimed product and the Jennings '063 product, the claims should be allowable as being novel and non-obvious product-by-process claims.

Thus, because Jennings '063 does not disclose all of the limitations in claims 1, 3, 60, 64 and 66 and because an analysis of the claims for product-by-process does not hold the product of the claims as obvious, independent claims 1, 3, 60, 64, and 66 are allowable over Jennings '063. Dependent claims 8-9, 54-55 and 61-63 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

3. Rejections Based on Lawson '782.

Claims 1, 3, 8, 9, 54, 55, 60-64, and 66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,550,782 to Lawson ("Lawson '782"). The Examiner indicated that Lawson '782 discloses a plurality of inner casings (32, 34, 36 in FIG. 1) that are indirectly coupled to the interior surface of an outer casing (16/14 in FIG. 1).

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a. Lawson '782 does not teach all the elements of the current claims.

Claims 1, 3, 60 and 64 are directed to a wellhead and an apparatus and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." These limitations are not disclosed in Lawson '782. As stated by the Examiner, Lawson '782 discloses that the inner casings (14, 16) are indirectly coupled to the outer casing (18) by hanger assemblies (10, 12). Lawson '782 does not disclose or suggest any contact pressure between the outer surface of each of the plurality of inner casings and the interior surface of the outer casing, as recited in claim 1, 3, 60 and 64. Since Lawson '782 does not teach all the limitations of claims 1, 3, 60 and 64, rejection under 35 U.S.C. § 102 is improper.

b. Lawson '782 does not suggest or motivate the modification to eliminate the indirect coupling components.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference or combine the reference teachings. See MPEP § 706.02(j). The device taught in Lawson '782 sufficiently couples the inner casing and the outer casing with the method described therein. The Lawson '782 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical indirect coupling. The coupling components are prominent throughout the disclosure. If Lawson '782 was modified to include expanding of the inner casing (or tubular member) such as covered by claims 1, 3, 60 and 64, such expansion would supplant the important coupling components, defeating the purpose of the intricate indirect coupling. Accordingly, contrary to claims 1, 3, 60 and 64, Lawson '782 provides no suggestion or motivation to expand the inner casing (or tubular member) such that the outer surface of such inner casing (or tubular member) creates contact pressure with the inner surface of the outer casing (or tubular member). It is therefore improper

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to find eliminating these important indirect coupling components obvious under 35 U.S.C. § 103(a).

c. A product-by-process analysis of the claimed product does not warrant a finding as obvious over Lawson '782 .

Claims 1, 3, 60, 64 and 66 possess product-by-process or product-by-process-like wording. Analysis of a product-by-process claim has two steps. The Examiner must first show that the claimed product appears to be the same or similar to that of the prior art. See MPEP § 2113. The second step is to determine if there is an unobvious difference between the claimed product and the prior art product, with the burden to establish an unobvious difference falling on the Applicant. See *Id.*

Claims 1, 3, 60 and 64 are directed to a wellhead and an apparatus, and positively claim the elements of "contact pressure," and that the contact pressure is "between an outer surface of each of the plurality of inner casings [or inner tubular members] and the interior surface of the outer casing [or tubular member]." In claim 66, contact pressure is implied by "expanding ... the inner tubular members into contact," and that contact pressure happens between "the inner tubular members" and "the interior surface of the outer tubular member."

i. The claimed product is not the same or similar to the prior art product.

The Applicant respectfully submits that a contact pressure coupling is not the same or similar to the complex indirect coupling of Lawson '782 . The Lawson '782 device includes numerous intricate components that precisely interact to accomplish a subtle mechanical coupling that the Examiner admits is indirect. Accordingly, the Examiner has failed to satisfy the first step in the analysis of a product by process claim, and, therefore, the specific analysis for an unobvious difference between the products is unnecessary, and the claims should be allowable as being novel and non-obvious.

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ii. There is an unobvious difference between the claimed product and the prior art product.

Assuming for the purpose of argument that the first step is met, the difference created by "expanding each inner casing (or tubular member)" imparts distinctive structural characteristics to the casing or tubing, e.g., having a outer surface devoid of components, so that a direct contact pressure may be established to an inner surface, similarly devoid of components. "The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially ... where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." MPEP § 2113. Terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" have been separately held to instill structural limitations, rather than merely describe a process. See, e.g., *In re Garner*, 412 F.2d 276, 279. "Expanding," in regards to a casing or tubular structure, should similarly be held to instill a structural limitation of having the same surfaces, devoid of components, in a larger diameter as the casing or tubular structure had in the original diameter. "Expanding" does not include adding the indirect coupling components essential to Lawson '782 .

Lawson '782 teaches components are essential to the indirect coupling. Lawson '782 neither suggests nor motivates one to eliminate the indirect coupling components. As such, the wellhead and apparatus of claims 1, 3, 60, 64 and 66 can not be obvious over the Lawson '782. Since the Applicant is able to prove an unobvious difference between the claimed product and the Lawson '782 product, the claims should be allowable as being novel and non-obvious product-by-process claims.

Thus, because Lawson '782 does not disclose all of the limitations in claims 1, 3, 60, 64 and 66, and because an analysis of the claims for product-by-process does not hold the product of the claims as obvious, independent claims 1, 3, 60, 64, and 66 are allowable over Lawson '782. Dependent claims 8-9, 54-55 and 61-63 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

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C. Claim Rejections Under 35 U.S.C. § 103(a).

Claims 4–7 and 50–53 were rejected under 35 U.S.C. § 103(a) as being obvious over combinations of Wester '579, Jennings '063, or Lawson '782, as applied to claims 1 and 3, in view of U.S. Patent No. 6,354,373 to Vercaemer, et al. ("Vercaemer '373"). The Examiner indicated that Vercaemer '373 teaches an inner casing (29 in FIG. 5) that is extruded off a mandrel (36 in FIG. 5) to expand the casing.

1. Wester '579, Jennings '063, or Lawson '782, in view of Vercaemer '373, do not teach all the elements of the current claims.

As discussed above, independent claims 1 and 3, as amended, are allowable over Wester '579, Jennings '063, and Lawson '782, because none of the cited references show contact pressure between an outer surface of each of the plurality of inner casings (or tubular members) and an interior surface of the outer casing (or tubular member). Vercaemer '373 does not make up for these deficiencies. Vercaemer '373 does not show contact pressure between an outer surface of each of the plurality of inner casings (or tubular members) and an interior surface of the outer casing (or tubular member). Thus, independent claims 1 and 3 are allowable over the combination of Wester '579, Jennings '063, or Lawson '782 with Vercaemer '373. Dependent claims 4–7 and 50–53 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

2. Wester '579, Jennings '063, or Lawson '782, in view of Vercaemer '373, do not suggest or motivate the modification to eliminate their respective indirect coupling components.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference or combine the reference teachings. See MPEP § 706.02(j). The device disclosed in Wester '579, Jennings '063, and Lawson '782, sufficiently couple the inner casing and the outer casing with the components described therein. The devices disclosed in Wester '579, Jennings '063, and Lawson '782 include numerous intricate components that precisely interact to accomplish subtle mechanical

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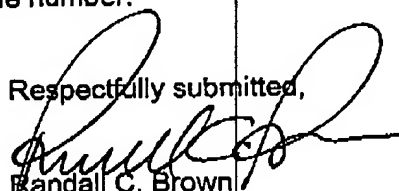
indirect couplings. The coupling components are prominent throughout the disclosures. If Wester '579, Jennings '063 or Lawson '782 are modified to include expanding of the inner casing (or tubular member) such as covered by claims 1, 13, 60, 64 and 66, such expanding would supplant the important coupling components, defeating the purpose of the intricate indirect coupling. Accordingly, contrary to claims 1, 3, 60, 64 and 66, Wester '579, Jennings '063, and Lawson '782 provide no suggestion or motivation to expand the inner casing (or tubular member) such that the outer surface of such inner casing (or tubular member) creates contact pressure with the inner surface of the outer casing (or tubular member). It is therefore improper to find eliminating these important indirect coupling components obvious under 35 U.S.C. § 103(a).

IV. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are drawn to novel subject matter, patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and allow the claims presented for reconsideration herein. To the extent that the present amendment results in additional fees, the Applicant authorizes the Commissioner to charge deposit account no. 08-1394.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,


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